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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,228	07/19/2001	Lawrence G. Almeda	LGA 0102 PUS	9723

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Lawrence G. Almeda  
2501 S. Christian Hills Drive  
Rochester Hills, MI 48309

EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/909,228	<b>Applicant(s)</b> ALMEDA ET AL.	
	<b>Examiner</b> Bradley Edelman	<b>Art Unit</b> 2153	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This is a first Office action on the merits of this application. Claims 1-22 are presented for examination.

#### ***Drawings***

1. The drawings are objected to because Figures 1 and 4 fail to include adequate labels or an adequate legend. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

Art Unit: 2153

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitations of an "effective date of the update, and time period of the update," which appear in claims 8 and 18, do not appear in the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 8 and 18 describe including an effective date of the update and a time period of the update of the address change in the database. However, these claims do not disclose how such a date is determined or how it ends up in the database. There are potentially various ways in which these claimed steps could occur, but Applicant has not indicated the particular methods used to implement the claim language. Therefore, a person having ordinary skill in the art would not know which method to use to implement the claimed features, and these claims are thus not enabled by the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-7, 10-13, 15-17, and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei (U.S. Patent No. 6,654,779).

In considering claim 1, Tsuei discloses a method of managing an update of a changed email address of a first client of a first system, the update being managed by the first system, the method comprising:

providing an old email address and a new email address of the first client (i.e. recipient), and providing an email historical database associated with the first system in which information of the old and new email addresses are stored, the email historical database being in communication with the first system via a communication network (col. 12, lines 19-21, "the EAMS 330 creates a record in its database 338 containing the old e-mail address in association with the new e-mail address");

sensing a subsequent email address of a subsequent email message to be sent from a second client (i.e. sender) of the first system (col. 9, lines 4-6, "a sender

Art Unit: 2153

composes a message at his or her computer and addresses it to the address believed to be correct for an intended recipient”);

searching in the email historical database to determine whether the subsequent email address is the old email address of the first client (col. 9, lines 60-63, “EAMS 330 searches its database [to] see if it contains a record relating to a new address to the address contained in the address query”); and

redirecting the subsequent email message to the new email address of the first client, if the subsequent email address is determined to be the old email address of the first client (col. 10, lines 25-37, “if there is an EAMS match for the address... the message is then delivered to the intended recipient [using the new address]).

In considering claim 2, Tsuei further discloses inputting the old email address and the new email address into the email historical database associated with the first system (col. 12, lines 19-21, “the EAMS 330 creates a record in its database 338 containing the old e-mail address in association with the new e-mail address”).

In considering claim 3, Tsuei further discloses that inputting the old and new email addresses is performed during a period of the first client’s subscription with the first system (col. 10, lines 38-41, “registration process 500 in which persons with e-mail addresses or mailboxes (‘consumers’) provide information to the disclosed EAMS 330 for the purpose of maintaining the cross reference table or database”).

In considering claim 5, Tsuei further discloses determining whether the subsequent email address is the old email address of the first client (col. 9, lines 60-64, wherein the database search does this).

In considering claim 6, Tsuei further discloses confirming with the second client that the subsequent email address is the old email address (col. 10, lines 30-31, "notifies the sender via e-mail of the intended recipient's new address," wherein such notification necessarily informs the sender that the subsequent address is an old email address).

In considering claim 7, Tsuei further discloses that the information includes data indicative of the first client (col. 12, lines 19-27, wherein the information includes a consumer authenticator in addition to other information indicative of the first client).

In considering claim 10, Tsuei further discloses that the first system includes a system of an Internet carrier ("ISP"), a system of hard-drive for a central processing unit (inherent in a server), and a local area network, metropolitan area network, and wide area network (all inherently part of the Internet).

In considering claim 11, Tsuei further discloses that the communication network includes a local area network, a metropolitan area network, a wide area network, the Internet, and an Intranet (these are all inherent parts of the Internet).

In considering claim 12, Tsuei discloses a method of managing an update of a changed email address of a user, the update being managed by a first system, the method comprising:

- providing an old email address and a new email address of the user, and providing an email historical database associated with the first system in which information of the old and new email addresses are stored, the email historical database being in communication with the first system via a communication network (col. 12, lines 19-21);

- providing a second system for a second client ((recipient's ISP"), the second system being in communication with the first system via the communication network (Fig. 3);

- sending a subsequent email from the second client, the subsequent email having a subsequent email address (col. 9, lines 4-6);

- determining the subsequent email is undeliverable (col. 9, lines 49-52);

- searching in the email historical database to determine whether the address of the subsequent email is the old email address of the user (col. 9, lines 60-63); and

- redirecting the subsequent email message to the new email address of the user, if the subsequent email address is determined to be the old email address of the user (col. 10, lines 25-37).



Art Unit: 2153

In considering claim 13, Tsuei further discloses inputting the old email address and the new email address into the email historical database associated with the first system (col. 12, lines 19-21, "the EAMS 330 creates a record in its database 338 containing the old e-mail address in association with the new e-mail address").

In considering claim 15, Tsuei further discloses determining whether the subsequent email address is the old email address of the user (col. 9, lines 60-64, wherein the database search does this).

In considering claim 16, Tsuei further discloses confirming with the second client that the subsequent email address is the old email address (col. 10, lines 30-31, "notifies the sender via e-mail of the intended recipient's new address," wherein such notification necessarily informs the sender that the subsequent address is an old email address).

In considering claim 17, Tsuei further discloses that the information includes data indicative of the user (col. 12, lines 19-27, wherein the information includes a consumer authenticator in addition to other information indicative of the first client).

In considering claim 20, Tsuei further discloses that the first system includes a system of an Internet carrier ("ISP"), a system of hard-drive for a central processing unit

Art Unit: 2153

(inherent in a server), and a local area network, metropolitan area network, and wide area network (all inherently part of the Internet).

In considering claim 21, Tsuei further discloses that the first system includes a system of an Internet carrier ("ISP"), a system of hard-drive for a central processing unit (inherent in a server), and a local area network, metropolitan area network, and wide area network (all inherently part of the Internet).

In considering claim 22, Tsuei further discloses that the communication network includes a local area network, a metropolitan area network, a wide area network, the Internet, and an Intranet (these are all inherent parts of the Internet).

***Claim Rejections - 35 USC § 103***

5. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei.

In considering claims 4 and 14, Tsuei further discloses notifying the second client if the message is undeliverable (col. 10, lines 26-27). However, Tsuei does not disclose requesting authorization from the second client to search in the email historical database to determine if the subsequent email address is the old email address of the first client and receiving authorization from the second client to search in the email database. Nonetheless, this feature of notifying a user when a message is undeliverable, and then giving the user an option of determining if the address of the

Art Unit: 2153

message is associated with a new valid address is well known, and is discussed by Tsuei as prior art (col. 2, lines 40-49). Thus, given this knowledge, it would have been obvious to a person having ordinary skill in the art to have the Tsuei system ask the email sender for authorization to search the EAMS database before searching it, just in case the user does not want to know the recipient's new e-mail address.

6. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, in view of Fuisz (U.S. Patent No. 6,389,455).

In considering claims 8 and 18, Tsuei further discloses that the information includes an old email address of the first client, the new email address of the first client, and identification of the first client (col. 12, lines 24-28). However, Tsuei does not explicitly disclose that the information also includes an effective date of the update and a time period of the update. Instead, Tsuei only discloses that the information includes "information corresponding to the change request" (col. 12, line 24), and that such information can be used in case a dispute arises regarding whether the email address change was authorized (col. 12, lines 26-28).

Nonetheless, including a date and time period of such e-mail address changes in an e-mail address redirection system is well known, as evidenced by Fuisz (Figs. 3a, 4; col. 4, lines 53-55, "the enabling function 103 permits a User to enter dates 103a and times 103b that govern when a forwarding e-mail address is turned on or off"). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of including a date and time period of address updates

as the "information" in the system taught by Tsuei, so that the user can prepare forwarding accounts in advance of actually activating them, thereby providing a reasonable time window of preparation. Therefore, it would have been obvious to include an effective date and a time period as the information in the system taught by Tsuei.

7. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, in view of Sommerer (U.S. Patent No. 6,694,353).

In considering claims 9 and 19, although the system taught by Tsuei discloses substantial features of the claimed invention, it does not disclose requesting authorization from the second client to redirect the subsequent email message to the new email address, and receiving authorization from the second client to redirect the subsequent message to the new email address. Nonetheless, this features is well known in systems that redirect email messages from an old email address to a new email address, as evidenced by Sommerer (see col. 4, lines 42-48, "attempting to direct a message to an expired address results in a notification to the user that the address is considered expired and that a newer address is known. The user is provided with an option of replacing the entered destination with the newer address"). Given this knowledge, it would have been obvious to a person having ordinary skill in the art to have the Tsuei system ask the email sender for authorization to redirect the message to the new email address, just in case the user does not want to or is not permitted to send messages to particular e-mail addresses.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 703-306-3041. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Bradley Edelman*

BE  
September 24, 2004